

REMARKS

Claims 1-48 remain in the application. Claims 13-24 and 34-36 stand allowed. Claims 42, 44 and 48 stand objected to but are held to distinguish over the prior art. Claims 1-12, 25-33, 37-41, 43 and 45-47 stand rejected. The undersigned appreciates the Examiner's finding that the Bindlish reference was overcome by the Declaration under 37 CFR 1.131.

The Examiner indicated that the original Patent or an Affidavit or Declaration as to the loss or inaccessibility of the original patent must be received before the reissue application can be allowed. The undersigned has requested the Assignee to provide the original patent or to execute an Affidavit or Declaration as to its loss or inaccessibility. Applicants are attempting to determine the status of the original patent and will provide an appropriate response before the application can be allowed. Applicants therefore respectfully request that compliance with this requirement be deferred until such time as the information becomes available.

The Examiner has requested a clean copy of the specification with the Certificate of Correction changes incorporated therein. A copy of such a clean specification is attached hereto.

The Examiner rejected claims 1-12 under 35 USC 112, first paragraph:

"as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites "an interface for receiving words of pixel data, each said word associated with an address buffer". There is no clear written description in the specification of "an address buffer".

The claim language for which the Examiner finds no written description is contained in claim 1 as it was originally filed. In addition, the specification provides ample support for such a language. See, for example, page 12, line 30 to page 14, line 10. See also page 11, line 2 through page 11, line 29 (and especially lines 12-22). There are also other places throughout the specification which provide more than adequate written description for the claim language in question. Accordingly, since the claim language in question was part of the original claims and is described in the original specification, Applicants respectfully request that the Examiner withdraw the rejection under 35 USC 112, first paragraph.

The Examiner rejected claims 25-33 under 35 USC 112, second paragraph, as indefinite because the limitation "said playback data" in column 17, line 42 has "insufficient antecedent basis." Claims 26-33 are dependent upon claim 25 and the Examiner therefore considered them to similarly lack antecedent basis. Applicants have amended claim 25 to ensure that the claim is definite and has adequate antecedent basis.

The Examiner rejected claims 37-39 and 41 under 35 USC 102(e) as anticipated by U.S. Patent No. 5,406,306 to Siann et al.

The Examiner rejected claims 1-6 and 12 under 35 USC 103 as unpatentable over Siann et al. in view of Herbert and Gery.

The Examiner rejected claims 40, 43 and 45-47 under 35 USC 103 as unpatentable over Siann et al. in view of Gery.

Each of these rejections is predicated upon the Siann et al. reference.

The Siann et al. reference was discussed in the public version of the Initial Determination by the presiding Administrative Law Judge for the International Trade Commission in investigation number 337-TA-412 entitled In the Matter of Certain Video

Graphics Display Controllers and Products Containing Same. A discussion of the Siann et al. reference occurs on pages 95 and 96 of that document. Summarizing, the staff of the International Trade Commission, the presiding Administrative Law Judge of the International Trade Commission and the expert witness for ATI Technologies, Inc. all determined that the Siann et al. reference does not have circuitry for "selectively retrieving" as required by claim 37. This finding was not reversed by the entire Commission.

This is directly contrary to the Examiner's finding on page 4 of the Office Action that "Siann teaches 'circuitry for selectively retrieving' at col. 4 lines 59-col. 5 line 13."

The portion of Siann et al. referred to by the Examiner reads as follows:

"The display memory 52 may have a first portion 54 for storing graphics information and a second portion 56 for storing video information. The graphics information stored in the portion 54 of the display memory 52 provides the data for the pixels on the face 10 of the video monitor 12 outside of the window 14 and also provides coded data signals at the pixel positions within the window 14 for insuring that the video information in the portion 56 of the display memory 52 will be displayed in the window.

The video information stored in the portion 56 of the display memory 52 provides input data to generate the color pixels in the window 14 on the face 10 of the video monitor 12. The video information stored in binary form in the portion 56 may indicate the luminance and the two (2) quadrature components of chrominance for each pixel. The video information stored in binary form in the portion 56 of the display memory 52 may be in a compressed form which may be decompressed to provide 320 video pixels in each of 240 lines. The graphics information stored in the portion 54 of the memory 52 may be in the form of 1024 pixels stored for each of the 768 lines."

A consideration of the words of the portion of the Siann et al. patent referred to by the Examiner does not show any teaching of "circuitry for selectively retrieving" as required

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by the claim language. Further, the Examiner's position is expressly contradicted by the findings of the ITC staff, the ITC presiding Administrative Patent Judge and ATI's own expert.

The Examiner's findings cannot ignore the determinations of the courts nor of the experts. *In re Meng*, 492 F2d 843, 181 USPQ 94 (CCPA 1974).

Further, if the Examiner is attempting to rely on a doctrine of inherency, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Hansgrig v. Kemmer*, 40 USPQ 667 (CCPA 1939); *In re Oelrich*, 666 F2d 578, 581, 212 USPQ 323, 326 (CCPA 1981).

Arguments other than those expressly set forth above were asserted during related litigations. The fact that some of those arguments are not repeated at this time does not mean that those other arguments are waived or are not significant. Rather, the arguments expressly asserted in this response are considered sufficient to overcome the examiner's rejections.

In the face of express findings by the court, Applicants respectfully request that the Examiner reconsider the holding that Siann et al. teaches "circuitry for selectively retrieving" as required by the claims. Independent claims 1, 37 and 43 each require this limitation. These are all of the independent claims under rejection by the Examiner on prior art. Since Siann et al. do not teach or suggest limitation of the claims under rejection, Applicants respectfully request the Examiner to withdraw the rejection and permit the application to issue as a patent.

For the reasons given, Applicants believe that the application is in condition for allowance and Applicants request that the Examiner give the application favorable consideration and permit it to issue as a patent.

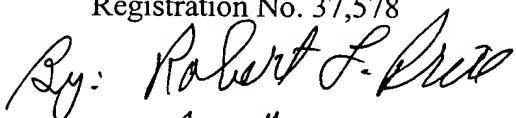
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Respectfully submitted,

MCDERMOTT, WILL & EMERY



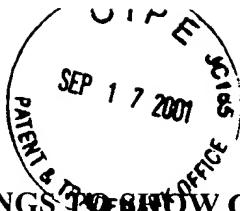
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VERSION WITH MARKINGS TO SHOW CHANGED MADE

IN THE SPECIFICATION:

Please see the attached substitute specification, which is a clean copy of the specification incorporating all of the changes made by Certificate of Corrections of U.S. Patent No. 5,598,525.

IN THE CLAIMS:

Claim 25 has been amended as follows:

25. (Twice Amended) A display system comprising:
a first backend pipeline for processing data;
a second backend pipeline for processing graphics data disposed in parallel to said first processing pipeline;

a multi-format frame buffer memory having on-screen and off-screen areas each operable to allow said frame buffer to simultaneously store data in graphics and video formats;

a input port for receiving both graphics and video data, each word of said data associated with an address directing said word to be processed as either graphics or video data;

circuitry for writing a word of said [playback] graphics and video data into a selected one of said areas of said multi-format memory;

memory control circuitry for controlling the transfer of data between said first backend pipeline and said frame buffer and between said second backend pipeline and said frame buffer;

a display unit; and

overlay control circuitry for selecting for output to said display unit between data provided by said first backend pipeline and data provided by said second backend pipeline.